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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/900,708
Filing Date	July 6, 2001
First Named Inventor	Keith D. Allen
Art Unit	1636
Examiner Name	Celine X. Qian
Attorney Docket Number	R-733

Total Number of Pages in This Submission

ENCLOSURES *(Check all that apply)*

- [x] Fee Transmittal Form
- [ ] Fee Attached
- [x] Amendment/Reply
- [x] After Final
- [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Response to Missing Parts/ Incomplete Application
- [ ] Response to Missing Parts under 37 CFR 1.52 or 1.53
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____
- [ ] After Allowance communication to Technology Center (TC)
- [ ] Appeal Communication to Board of Appeals and Interferences
- [ ] Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- [ ] Proprietary Information
- [ ] Status Letter
- [ ] Other Enclosure(s) (please Identify below):

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Kelly L. Quast, Reg. No. 52,141
Signature	Kelly L Quast
Date	August 21, 2003

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	DON MIXON		
Signature	Don Mixon	Date	August 21, 2003

PTO/SB/17 (08-03)
Approved for use through 07/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

FEE TRANSMITTAL for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

☑ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 55.00

Complete if Known	
Application Number	09/900,708
Filing Date	July 6, 2001
First Named Inventor	Keith D. Allen
Examiner Name	Celine X. Qian
Art Unit	1636
Attorney Docket No.	R-733

METHOD OF PAYMENT *(check all that apply)*

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☑ Deposit Account:

Deposit Account Number: 50-1271

Deposit Account Name: Deltagen, Inc.

The Director is authorized to: *(check all that apply)*

☐ Charge fee(s) indicated below ☐ Credit any overpayments

☐ Charge any additional fee(s) during the pendency of this application

☐ Charge fee(s) indicated below, **except for the filing fee** to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1001	750	2001	375	Utility filing fee	
1002	330	2002	165	Design filing fee	
1003	520	2003	260	Plant filing fee	
1004	750	2004	375	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) ($)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below	Fee Paid
Total Claims		-20** =		X	=
Independent Claims		- 3** =		X	=
Multiple Dependent					=

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	84	2201	42	Independent claims in excess of 3
1203	280	2203	140	Multiple dependent claim, if not paid
1204	84	2204	42	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for *ex parte* reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	55.00
1252	410	2252	205	Extension for reply within second month	
1253	930	2253	465	Extension for reply within third month	
1254	1,450	2254	725	Extension for reply within fourth month	
1255	1,970	2255	985	Extension for reply within fifth month	
1401	320	2401	160	Notice of Appeal	
1402	320	2402	160	Filing a brief in support of an appeal	
1403	280	2403	140	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,300	2453	650	Petition to revive - unintentional	
1501	1,300	2501	650	Utility issue fee (or reissue)	
1502	470	2502	235	Design issue fee	
1503	630	2503	315	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	750	2809	375	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	750	2810	375	For each additional invention to be examined (37 CFR 1.129(b))	
1801	750	2801	375	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) ($) 55.00

SUBMITTED BY				(Complete *(if applicable)*)	
Name *(Print/Type)*	Kelly L. Quast	Registration No. *(Attorney/Agent)*	52,141	Telephone	650-569-5100
Signature	Kelly L Quast			Date	August 21, 2003

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS **ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Keith D. ALLEN	Group Art Unit:	**1636**
Serial No.:	09/900,708	Examiner:	**Qian, Celine X.**
Filed:	July 6, 2001	Customer No.	**26619**
Title:	Transgenic Mice Containing Intestinal Alkaline Phosphatase Gene Disruptions	Docket/Order No.	**R-733**
		Date:	**August 21, 2003**

AFTER FINAL AMENDMENT

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed April 23, 2003, made final by the Examiner, in connection with the above-identified application, Applicant requests entry and consideration of the following amendments and remarks. Applicant submits concurrently herewith a Petition for Extension of Time for a period of one (1) month from July 23, 2003, up to and including August 23, 2003.

The Applicant submits that this Amendment follows the revised format described in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, published in *Official Gazette* on February 25, 2003. As such, only one copy of each replacement paragraph, section or claim is required. Further, amendments to the claims are made by presentation of a complete listing of all claims including any amendments.

RJD

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
09/900,708	07/06/2001	Keith D. Allen	R-733	3959

7590 04/23/2003

DELTAGEN, INC.
1003 Hamilton Avenue
Menlo Park, CA 94025

EXAMINER
QIAN, CELINE X

ART UNIT	PAPER NUMBER
1636	

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

RESP DUE 23-JULY-03

Office Action Summary	Application No.	Applicant(s)	
	09/900,708	ALLEN, KEITH D.	
	Examiner	Art Unit	
	Celine X Qian	1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-16 and 29-46* is/are pending in the application.

4a) Of the above claim(s) *11-16 and 29-34* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *35-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 11-16, 29-46 are pending in the application.

Claims 1-10, 17-28 are cancelled. Claims 11-16 and 29-34 are withdrawn from consideration for being directed to non-elected subject matter. Claims 35-46 are currently under examination.

This Office Action is in response to the Amendment filed on 2/3/03.

Response to Amendment

The rejection of claims 8-10 and 17-28 under 35 U.S.C. 112 1st paragraph is moot in light of Applicants' cancellation of the claims.

The rejection of claims 1-4, 9, 10 and 28 under 35 U.S.C. 112 2nd paragraph is moot in light of Applicants' cancellation of the claims.

The rejection of claims 1-8 and 10 under 35 U.S.C. 103 (a) is moot in light of Applicants' cancellation of the claims.

The newly added claims 35-46 are rejected under 35 U.S.C. 112 1st paragraph (scope of enablement) for reasons discussed below.

The newly added claim 40 is rejected under 35 U.S.C. 112 2nd paragraph for reasons discussed below.

The newly added claims 42-46 are rejected under 35 U.S.C.103 (a) for reasons discussed below.

New Grounds of Rejection Necessitated by Applicants' Amendment

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 35-46 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a homozygous intestinal alkaline phosphatase gene knockout mouse that **lacks production of functional intestinal alkaline phosphatase protein and exhibits the disclosed phenotype of abnormal activity level**, a method of making said mouse, does not reasonably provide enablement for a transgenic mouse comprising any type of intestinal alkaline phosphatase disruption, and exhibits the phenotype of a nociceptive abnormality. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The newly added claims 35-41 are rejected for same reasons as applied to now cancelled claims 8-10 and 17-28 that set forth of the record mailed on 8/26/03 (see pages 3-5).

The nature of the invention is a transgenic mouse comprising a disruption in the intestinal alkaline phosphatase gene and exhibits phenotype comprising a nociceptive abnormality and abnormal activity level; target construct of intestinal alkaline phosphatase gene and a method of making said transgenic mouse. The specification discloses a method for generating said mouse by homologous recombination using an intestinal alkaline phosphatase-targeting construct (see page 51-54, examples 1). The specification further discloses that the homozygous knockout mice exhibit the phenotype comprising nociceptive abnormality and abnormal activity level as shown by the data presented in Table 1.

When considering the predictability of this invention, one has to remember that many of the phenotypes examined in transgenic knockout models are influenced by the genetic

background in which they are studied and the effect of allelic variation and the interaction between the allelic variants (pg.1425, col.1 1st paragraph, Sigmund, C.D. 2000. Arterioscler Thromb Vasc Biol.20:1425-1429). The specification discloses the phenotype of a homozygous intestinal alkaline phosphatase knockout mouse comprises a nociceptive abnormality and abnormal activity level. And the phenotype of an intestinal alkaline phosphatase knockout mouse is essential for the use of said mouse.

The specification discloses that the word "disruption" comprises alter or replace a promoter, enhancer, or splice site of a target gene, and can alter the normal gene product by inhibiting its production partially or completely or by enhancing the normal product's activity (see page 6-7, bridging paragraph). However, it is not known in the prior art that such "disruption," would produce the phenotype as disclosed by the specification. The specification only discloses a mouse with two alleles of intestinal alkaline phosphatase gene disrupted by inserting a selection marker, and said mouse exhibits the phenotype comprising a nociceptive abnormality and abnormal activity level. Thus, the phenotype of a transgenic mouse comprising a "disruption," as defined by the specification, in an intestinal alkaline phosphatase gene is unpredictable. Thus, the specification, in the instant case, is not enabling for transgenic knockout mice that exhibit no phenotype or that exhibit transgene-dependent phenotypes other than that disclosed in the instant specification. One skilled in the art would have to engage in undue amount of experimentation to make and use the invention commensurate in scope with these claims.

The specification discloses that the homozygous mutant mice display an increase in thermal sensitivity as demonstrated by decreased latency to lick their hindpaw during the hot

plate test. However, the specification only provides such data for two pair of mice. Moreover, one pair of mice display very similar latency (24.68 vs 23.28) to hindpaw licking (see Table 1, last col., 5 and 6th cell). It appears that this phenotype is inconsistent between two pairs of wild type and knockout mice. It is also unclear whether the hot plate test indicates thermal sensitivity, pain sensitivity and/or nociceptive sensitivity. As such, whether the IAP knockout mice exhibit the claimed phenotype of nociceptive disorder, increased pain sensitivity and increased thermal sensitivity is unpredictable. One skilled in the art would have to engage in undue experimentation to make and use the invention commensurate in scope with these claims.

This rejection may be overcome by amending the claims to recite only the transgenic knockout mouse that lacks production of functional intestinal alkaline phosphatase protein and exhibits the phenotype of abnormal activity.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation of "breeding the chimeric mouse to produce the transgenic" in step (d) renders the claim indefinite because it is unclear what is being produced. Appropriate correction is required.

Claim Rejections - 35 USC § 103

Claims 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mansour et al (1988, Nature, vol. 336, No. 24, 348-352), in view of Manes et al (1990, Genomics, vol.8: 541-554).

The claims are drawn to an intestinal alkaline phosphatase gene-targeting construct and a method of making said construct. The claims are further drawn to a cell comprising a disruption in the intestinal alkaline phosphatase gene. The recitation of "wherein the target construct when...exhibits a nociceptive abnormality or activity level abnormality" defines the intended use of the knockout construct, which does not carry patentable weight.

Mansour et al. teach a strategy for targeted disruption of the hprt and proto-oncogene int-2 in mice embryonic stem cells and subsequent generation of knockout mice. Their teaching addresses the previous technical difficulty of obtaining embryonic stem cell carrying non-selectable, targeted gene mutation at loci of interest, and therefore provides a model which can be used to produce homozygous mutation of any gene, regardless of its function, if a cloned fragment of the gene is available (see page 348, second paragraph, line 1-3, third paragraph, line 1-5, and page 352, fourth paragraph, line 1-3). Mansour et al. further teach the generation of two targeting constructs, pRV9.1/TK and pINT-2-N/TK, each contains two sequences from hprt and int-2 respectively, and a neo selection marker in between the two sequences (see page 350, figure 3). However, Mansour et al. do not teach how to make an intestinal alkaline phosphatase gene target construct and knockout mouse.

Manes et al. teach that alkaline phosphatases are highly ubiquitous enzymes present in most species from bacteria to man, and isozymes of tissue specific alkaline phosphatases share highly homologous organization with each other (see page 541, 1st col. lines 1-3, and 2nd col.,

lines 12-14). Manes et al. also teach that this family of genes represent a system suitable for approaching questions concerning the evolution of tissues specific genes and their restricted expression, the mechanisms underlying genetic polymorphism, as well as the progressive change in the catalytic properties and function of enzymes in the context of an isozyme family (page 551, 2nd col., 3rd paragraph, lines 1-2 through page 552, 1st col., lines 1-5). Manes et al. further teach the cloning of mouse IAP, EAP (tissue specific alkaline phosphatase isozyme family member) gene and provided genomic sequence of these genes (see Figure 1 and 3).

Based on the teaching of Manes et al. that alkaline phosphatase gene family represents a system suitable for studying the evolution of tissue specific genes and their restricted expression, it would have been obvious to one of ordinary skill in the art to knockout the tissues specific IAP to study its function. The ordinary artisan would have been motivated to knockout the expression of the IAP gene in a mouse to study the function of this gene in context of the alkaline phosphatase family, and understanding its structure function relationship in evolutionary process, as suggested by the teaching of Manes et al. Functional analysis of a specific gene by using a knockout mouse model is a common practice at the time of filing. The level of skill in the relevant art is high. Absent evidence to the contrary, one skilled in the art would have reasonable expectation of success to make a IAP knockout construct and transform a murine embryonic stem cell with the target construct by following teachings of Mansour et al. Therefore, the invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

No claims are allowed.

This application contains claims 11-16, 29-34 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celine X Qian whose telephone number is 703-306-0283. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel Ph.D. can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Celine Qian, Ph.D.
April 15, 2003

Anne-Marie Falk

ANNE-MARIE FALK, PH.D.
PRIMARY EXAMINER